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1753



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re United States Patent Application of:

Applicant: Donatucci, et al.

Application No.: 10/022,298

Date Filed: December 18, 2001

Title: VAPORIZER/DELIVERY  
VESSEL FOR  
VOLATILE/THERMALLY  
SENSITIVE SOLID AND  
LIQUID COMPOUNDS

Confirmation No. 1697

Docket No.: 2771-514

Examiner: Richard Bueker

Group Art Unit: 1763

Customer No.

**25559**

EXPRESS MAIL CERTIFICATE

I hereby certify that I am mailing the attached documents to the Commissioner for Patents on the date specified, in an envelope addressed to the Commissioner for Patents, Mail Stop Non-Fee Amendment, P. O. Box 1450, Alexandria, VA 22313-1450 and Express Mailed under the provisions of 37 CFR 1.10.

*Candace White*

Candace White

October 14, 2003

Date

EV247333443US

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**RESPONSE TO SEPTEMBER 16, 2003 OFFICE ACTION IN U. S. PATENT  
APPLICATION NO. 10/022,298**

Mail Stop Non-Fee Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In the Office Action dated September 16, 2003, Examiner Bueker imposed a restriction requirement under 35 U.S.C. §121 against claims 1-28 and required that an election be made between one of the following groups:

Group I (claims 1-14 and 25-28), drawn to an apparatus, classified in class 118, subclass 726; and

Group II (claims 15-24), drawn to a method, classified in class 427, subclass 248.1.

Applicant traverses such a restriction requirement and submits that the apparatus and method of using the vaporizer vessel are not patentably distinct from each other because one having a method of using the instantly claimed apparatus would obviously have to have the apparatus for performing such a vaporization method. Thus, the apparatus recited in claims 1-14 and 25-28 is not patently distinct from the method of using the apparatus as a vaporizer vessel. The interdependence of the apparatus claims and the method of using same is confirmed—indeed, it is mandated—by virtue of the fact that the description requirements of 35 U.S.C. §112 compel disclosure of different aspects of the invention in the one application which applicant has filed.

In addition, the courts have recognized that it is in the public interest to permit an applicant to claim several aspects of his/her invention together in one application, as the applicant has done herein. The CCPA has observed:

We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. §112 all aspects as to what they regard as their invention, regardless of the number of statutory classes involved. *In re Kuehl*, 456 F.2d 658, 666, 117 U.S.P.Q. 250, 256 (CCPA 1973).

This interest is consistent with the practical reality that a sufficiently detailed disclosure supporting claims to one aspect of an invention customarily is sufficient to support claims in the same application to other aspects of the invention.

It is vital to all applicants that restriction requirements issue only with the proper statutory authorization, because patents issuing on divisional applications that are filed to prosecute claims that the Office held to be independent and distinct can be vulnerable to legal challenges alleging

double patenting. The third sentence of 35 U.S.C. §121, which states that a patent issuing on a parent application “shall not be used as a reference” against a divisional application or a patent issued thereon, does not provide comfort to an applicant against such allegations. The Court of Appeals for the Federal Circuit has declined to hold that §121 protects a patentee from an allegation of same-invention double patenting, *Studiengesellschaft Kohle mbH v. Northern Petrochemical Co.*, 784 F.2d 351, 355, 228 U.S.P.Q. 837, 840 (Fed. Cir. 1986); and in *Gerber Garment Technology Inc. v. Lectra Systems Inc.*, 916 F.2d 683, 16 U.S.P.Q. 2d 1436 (Fed. Cir. 1990) that court held that §121 does not insulate a patentee from an allegation of “obviousness-type” double patenting, and in fact affirmed the invalidation on double patenting grounds of a patent that had issued from a divisional application filed following a restriction requirement.

Furthermore, it is far from clear that the step of filing a terminal disclaimer is available to resolve a double patenting issue that arises after the issuance of patent on the divisional application.

All these considerations indicate that the imposition of a restriction requirement with inadequate authority can lead to situations in which an applicant’s legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to protect a patentee’s rights and to serve the public’s interest, the Office is not to require restriction in cases, such as the present application, wherein various aspects of a unitary invention are claimed.

In view of the foregoing discussion, reconsideration for the withdrawal of the requirement for restriction is courteously requested. **In the event the requirement is adhered to, applicant provisionally elects with traverse, the invention of Group I (claims 1-14 and 25-28) reciting the apparatus for further examination on the merits.**

In accordance with Office guidelines recited in MPEP Section 821.04, elected apparatus (product) claims found to recite patentable subject matter **may be rejoined with the provisionally withdrawn method of use type claims** and examined in this one application provided the method of use claims recite the apparatus (product) found to be patentable during examination of the elected invention. In the event the apparatus claims 1-14 and 25-28 are found to recite patentable subject matter, non-elected method claims 15-24 should be taken up for examination.

**Fees Payable**

No fee is due for entry of this response. If nonetheless it is determined that any additional fee or charge is properly payable, the same hereby is authorized to be charged to Deposit Account No. 08-3284 of Intellectual Property/Technology Law.

Respectfully submitted,



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